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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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|---------------------------|--|
| Proceeding | 92055460 |
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
The Trademark Trial and Appeal Board**

Registration No. 3,878,276,
For the mark HACKETT CONSULTING,

The Hackett Group, Inc.

Petitioner,

vs.

Hackett Consulting,

Registrant.

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Cancellation No. 92055460

TRIAL BRIEF OF REGISTRANT HACKETT CONSULTING
(PUBLIC)

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COMES NOW the Registrant Hackett Consulting (hereinafter “Registrant”), by counsel, and respectfully submits its brief in opposition to the instant cancellation proceeding instituted by The Hackett Group, Inc. (hereinafter “Petitioner”).

PRELIMINARY STATEMENT

The instant matter comes before the Board on Petitioner’s Petition to Cancel Registrant’s registered trademark for the terms HACKETT CONSULTING as more fully set forth in U.S. Reg. No. 3,878,276 (hereinafter “Registrant’s Mark”).

Petitioner’s believes that it will be damaged by the continued registration of Registrant’s Mark on the grounds that Petitioner maintains prior rights in a line of “HACKETT” service marks granting them superior rights over those retained by Registrant.

As more fully set forth below, the du Pont factors weigh heavily in support of the continued registration of Registrant’s Mark. As recited in Registrant’s Mark Registrant’s services are wholly diverse from the services relied upon in Petitioner’s sole existing registration. Moreover, it is submitted that Petitioner’s mark(s) are entitled to a narrow scope of protection given their significance as a surname. There is no overlap in marketing or trade channels and no evidence of actual confusion despite a duration of time during which actual confusion could have occurred. Moreover, the purchasers of Petitioner’s services are highly sophisticated Fortune 500 companies making confusion all the less likely as between the registered trademarks.

Wherefore on the grounds more fully developed below, Registrant respectfully requests that the Board deny the requested relief sought by the Petitioner and permit Petitioner’s Mark to maintain being registered on the Supplemental Register of the U.S. Patent and Trademark Office.

THE RECORD BEFORE THE BOARD

The record before the Board includes the testimonial depositions of 2 witnesses, 2 notices of reliance, as well as 2 pleaded federal trademark registrations owned by Petitioner as set forth below:

Trial Testimony

| <u>Witness</u> | <u>Title</u> | <u>Date</u> |
|---------------------|--|-------------|
| 1. Anthony Snowball | Head of Global Benchmarking, The Hackett Group | 06/12/2013 |
| 2. Aaron Hackett | Principal, Hackett Consulting | 08/30/2013 |

Notices of Reliance

| <u>Submitting Party</u> | <u>Title</u> | <u>Filed</u> |
|-------------------------|-----------------------------|--------------|
| Petitioner | Notice of Reliance (First) | 06/13/2013 |
| Petitioner | Notice of Reliance (Second) | 06/17/2013 |

Petitioner's Pleased Federal Trademark Registrations¹

| <u>Trademark</u> | <u>U.S. Reg. No.</u> | <u>Registered</u> |
|----------------------------------|----------------------|-------------------|
| THE HACKETT GROUP | 3,064,697 | 03/07/2006 |
| HACKETT PERSPECTIVE ² | 3,229,134 | 04/17/2007 |

¹ The Hackett Group, Inc.'s pleaded registrations are made part of the record having been attached as exhibits to the initial Petition to Cancel pursuant to TBMP § 704.05(a).

² Of note, Reg. No. 3,229,134 was cancelled effective November 22, 2013 for a failure to file an acceptable declaration under Section 8.

STATEMENT OF FACTS

A. Hackett Consulting

Registrant was founded by Aaron Hackett (hereinafter “Mr. Hackett”) in 2008. Trial Deposition of Aaron Hackett dated August 30, 2013 (hereinafter “Registrant’s Deposition”) at pp. 6, 8. Mr. Hackett chose the term HACKETT for Registrant’s Mark because he wanted to use his last name for personal reputation reasons. Id. at 7. He combined it word with the word CONSULTING insofar as he “...wanted to use a single descriptor and one that was as short as possible.” Id. Finally, Mr. Hackett wanted a trademark for which the .com domain name was available for registration. Id. Combining these three factors, Registrant decided upon the trademark HACKETT CONSULTING. Registrant’s Trial Deposition at p. 7.

Of note, at the time Mr. Hackett founded the Registrant he had never heard of the Petitioner. Registrant’s Deposition at p. 8.

1. Registrant’s Mark

On or about December 12, 2009 Registrant applied to register Registrant’s Mark with the U.S. Patent and Trademark Office. Id. at p. 9; See also Registrant’s Deposition, Exhibit A. The application received Serial No. 77/892,182 and contained a date of first use of the trademark in interstate commerce of June 2, 2008. Registrant’s Deposition, Exhibit A. The services in the application are identified as follows:

Branding services, namely, consulting, development, management and marketing of brands for businesses in International Class 35.

Id.

On November 16, 2010 Registrant’s Mark registered with the U.S. Patent and Trademark Office. Registrant’s Deposition at p. 9; See also Registrant’s Deposition, Exhibit B. Registrant’s

Mark received Reg. No. 3,878,276 and is registered on the Supplemental Register with a disclaimer for the generic term CONSULTING. Registrant's Deposition, Exhibit B.

2. Registrant's Services

During his trial deposition, Mr. Hackett provided background testimony in regard to the definition of brand management so as to better define the services that the Registrant provides under Registrant's Mark as recited in its registration. See generally Registrant's Deposition at pp. 10-11. Specifically, Mr. Hackett testified that brand management can be broken down into four functions. Id. at p. 11.

First, assessing the competitive landscape. Registrant's Deposition at p. 11. Second, positioning your brand within the identified competitive landscape. Id. Third, the execution strategy for positioning of the brand. Id. Fourth, the actual execution or marketing work that is done to position the brand. Id.

Mr. Hackett clarified Registrant's recited services in Registrant's Mark stating that they fall squarely within the third and fourth segments of brand management, namely, creating execution strategies for the positioning of brands and executing those strategies once created. Registrant's Deposition at pp. 11-13. Specifically, his services, as recited in Registrant's Mark, entail the development of web sites for Registrant's small business clients, Facebook pages, as well as limited digital marketing and management of the clients' Twitter accounts. Id. at pp. 13-15.

When specifically asked to interpret the services listed in Registrant's Mark, Mr. Hackett testified:

[W]hen I read this, it says, for branding services, namely, consulting, development, management and marketing of brands for businesses. And that's exactly what I do. I make recommendation on what should be done. I develop

those activities and then I manage them all the way through so that's – in that – that hits what I do.

Registrant's Trial Deposition at pp. 37-38.

Mr. Hackett testified that Registrant performs no benchmarking services. Registrant's Deposition at p. 16. He further provided that the Registrant does not perform any business analysis reporting for benchmarking. Id. Mr. Hackett further provided that the first two areas of brand management, those charged with assessing the landscape, is where benchmarking is located. Id. at p. 38.

3. Registrant's Consumers

The consumers of Registrant's services are small companies with minimal budgets. Registrant's Deposition at p. 13. Most cannot afford "...TV, print, radio..." advertising so they relegate themselves to Facebook and Google ads with no up-front costs that can be turned off and on with minimal investment. Id. at p. 14.

As is set forth explicitly on the home page of Registrant's web site, Registrant's services are directed specifically at those individuals and businesses on a "...lean marketing budget." Registrant's Deposition at p. 23. See also Registrant's Deposition at Exhibit C. Its services are "...not relevant to big companies ... big companies have marketing groups that do exactly what [Registrant does]." Registrant's Trial Deposition at p. 23.

Registrant's consumers typically have less than one million dollars in annual sales and many times less than \$200,000 per year in annual sales. Id. at pp. 23-24. These companies, Registrant's consumers, on average have less than ten (10) employees. Id. at p. 24. Registrant has never had a client the size of Coca-Cola. Id at p. 32.

4. Registrant's Marketing

Registrant's services are marketed mainly through word of mouth and through individuals that personally know Mr. Hackett. Registrant's Deposition at p. 16. Registrant's services are also marketed through its website located at www.hackettconsulting.com. Id. at p. 17. See also Registrant's Deposition, Exhibit C. Registrant's website does not generate new client contacts. Rather, it is used as a tool to build credibility with prospective customers once they have heard of Registrant's services by and through word-of-mouth advertising. Id. at p. 19. As Mr. Hackett testified, one hundred percent of the work Registrant receives is from word-of-mouth referrals. Id. at p. 20.

The Registrant does not produce and send newsletters to clients. Registrant's Deposition at p. 20. The Registrant does not get referrals from Fortune 500 or 100 companies. Id. The Registrant does not hold conferences for Fortune 500 or 100 executives. Id. at p. 21. The Registrant does not perform webcasts. Id.

5. Registrant's Channels of Trade

Registrant's services reach each of its customers by and through Mr. Hackett working alone with Registrant's customers. Registrant's Deposition at p. 21. Often the services are provided in the basement of Mr. Hackett's personal residence located in Mableton, Georgia. Id. at pp. 5, 21.

Registrant does not retain offices in San Francisco, Chicago, New York City, Miami, Frankford, Germany, London, Sydney, Australia, or the Netherlands. Id. at pp. 21-22.

B. The Hackett Group, Inc.

Petitioner provides benchmarking services in the nature of surveys and analysis reports for the benchmarking of business processes. See Deposition of Anthony Snowball dated June 12, 2013 (hereinafter “Snowball Deposition”) at p. 8. See also Snowball Deposition, Exhibit 1. Petitioner has provided these services continuously since as early as 1992. Snowball Deposition at p. 9.

1. Petitioner’s Pleaded Trademark Registration

Petitioner’s sole existing registered trademark for its services is for the mark THE HACKETT GROUP, U.S. Reg. No. 3,064,697 (hereinafter “Petitioner’s Trademark”).³ Petitioner’s Trademark is registered in standard characters in connection with the following services in International Class 35:

Business consultation and analysis services, namely, providing surveys and analysis reports in the benchmarking of business processes.

U.S. Reg. No. 3,064,697.

2. Petitioner’s Benchmarking Services Defined

As Mr. Snowball testified:

Benchmarking is generally a technique used to measure performance and compare performance. So using a defined set of metrics, we would access an individual client’s performance; and continuing in the available of marketing, we would look at their overall marketing cost for a product management; we would look at their labor costs to deliver product management services; and we would accumulate that from our client and compare it to our database and compare it to leading companies as well, thereby benchmarking them.

And it would tell them or give them an indication of whether their performance was strong or weak relative to the comparison that was used.

³ As set forth above, Petitioner also relied upon Reg. No. 3,229,134 in its initial pleading. However, Reg. No. 3,229,134 was cancelled effective November 22, 2013 for a failure to file an acceptable declaration under Section 8.

Snowball Deposition at p. 11. [REDACTED]

[REDACTED] Id. at p. 56. Mr. Snowball added [REDACTED]

[REDACTED] Id. at p. 29.

3. Petitioner's Consumers for their Benchmarking Services

Mr. Snowball conceded in his trial testimony that Petitioner's benchmarking service "...is focused on preeminent brands..." Snowball Deposition at p. 13. Specifically, Petitioner has provided its services to the largest company in the world, Walmart, but has only dipped to provide services to companies that are around or slightly below the hundred million dollar mark in terms of revenue size. Id.

Mr. Snowball specifically testified that Petitioner's services "are most palatable to companies that are 500 million and above and most comfortable to a billion and above" further adding "I would be surprised if we marketed to a firm less than a million in revenue". Snowball Deposition at pp. 100-101. In reference to the smallest of clients served by Petitioner, Mr. Snowball testified "I know we have served very small clients through a benchmarking capacity ...companies around 25 million to 50 million in the benchmarking database." Id. at 101.

[REDACTED] Snowball Deposition, Exhibit 3, at PET 000387. [REDACTED]

[REDACTED]

[REDACTED] Id. See also Snowball Deposition at p. 38.

Mr. Hackett added that, based upon his experience working in the marketing departments of Fortune 500 companies, he had only seen brands of \$100 million or more get benchmarking studies like the kind provided by the Petitioner. Registrant's Deposition at pp. 46-47.

4. The Fortune 500 Procurement Process

Mr. Hackett provided testimony concerning the large corporate procurement process. See generally Registrant's Deposition at pp. 24-26. Specifically, vendors for large companies, such as The Hackett Group, Inc., are vetted by the large companies prior to becoming authorized vendors therefore. Id. at p. 25. The vetting process entails looking at different proposals from vendors, examining their cost structure, determining the quality of the vendor's work, and sometimes even going to the vendor's facilities to make sure that the same are adequate to provide services for the large company. Id. at pp. 25-26.

Based upon this knowledge, Mr. Hackett opined that it would not be conceivable for large Fortune 500 company to hire the wrong vendor. Id. at p. 26. (emphasis added).

5. Petitioner's Marketing

Petitioner relies heavily upon referrals and returning business from executives in large companies it has performed services for in the past. Snowball Deposition at p. 14. [REDACTED]

[REDACTED] Id. at pp. 78-79. These referrals come from the companies Petitioner represents, namely, large Fortune 500 companies and companies having no less than 25 million to 50 million [in sales per year]." Id. at p. 103. See also id. at pp. 38, 101; Snowball Deposition, Exhibit 3, at PET 000387.

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

7. Petitioner's Claim of Common Law Rights

Petitioner's contends that its services have recently moved from mere benchmarking analysis as identified in their relied-upon federal registration to also including consulting services. [REDACTED]

[REDACTED]

[REDACTED] Snowball Deposition at pp. 36-37.

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] Id. at p. 56.

Of note, Mr. Snowball provided a clear example of what he considered their consulting services to entail in terms of "prescriptive recommendations" as they apply to marketing. Mr. Snowball testified:

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Snowball Deposition at pp. 70-71.

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] Mr. Snowball added. Id. at p. 51.

Of note, there is little, if any testimony, concerning the alleged dates of first use concerning the “consulting services” now allegedly offered by the Petitioner.

ARGUMENT

CONTINUED REGISTRATION OF HACKETT CONSULTING WOULD NOT CREATE A LIKELIHOOD OF CONFUSION WITH THE HACKETT GROUP'S REGISTERED TRADEMARK

In a cancellation proceeding, the burden of proof is upon the party seeking cancellation of the registered trademark. *Cerveceria Centroamericana SA vs. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307 (Fed. Cir. 1989). Petitioner must establish that there is a likelihood of confusion by a preponderance of the evidence. The Board's decision is based upon a determination under Section 2(d) on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("du Pont"). See also *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). These factors are discussed below.

A. The Parties' Services are Dissimilar

In an inter partes proceeding before the Board, the issue of likelihood of confusion must be determined based on the services recited in challenged registration vis-à-vis the services identified in petitioner's pleaded registration(s). *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992).

As defined in the subject registration, Registrant's services are listed as:

Branding services, namely, consulting, development, management and marketing of brands for businesses.

As defined in the pleaded registration by Petitioner, Petitioner's relied-upon services are:

Business consultation and analysis services, namely, providing surveys and analysis reports in the benchmarking of business processes.

Facially, the services as recited in the respective registrations are immediately distinguishable. Petitioner provides benchmarking services in the nature of providing surveys and analysis of business processes. In the alternative, Registrant provides branding services in the nature of consulting on the creation of brands and the development and specific marketing of the same. In short, Petitioner provides analytical benchmarking services designed to measure the effectiveness of business processes. Registrant helps to create small businesses' brands and market the same.

Accordingly, merely examining the services as recited in the respective registrations should be sufficient to determine that the services of the respective parties are separate and distinct. However, this analysis is not submitted in a vacuum. In addition to the services as recited in the registrations, both trial witnesses in this case provided detailed testimony defining and setting forth the distinctions between the services of the parties as contained in the applicable registrations.

In regard to the Registrant's services, Mr. Hackett clarified that his branding services, as set forth in Registrant's Mark, consist of creating an execution strategy for the positioning of brands and executing the strategy for that placement. Registrant's Deposition at pp. 11-13. Specifically, this entails the development of web sites for Registrant's small business clients, Facebook pages, as well as limited digital marketing and management of their Twitter accounts. Id. at pp. 13-15.

Separate and distinct from Registrant's services as set forth in Registrant's Mark, Mr. Snowball further clarified Petitioner's services as recited in Petitioner's sole registered service mark:

Benchmarking is generally a technique used to measure performance and compare performance. So using a defined set of metrics, we would assess an individual

client's performance; and continuing in the available of marketing, we would look at their overall marketing cost for a product management; we would look at their labor costs to deliver product management services; and we would accumulate that from our client and compare it to our database and compare it to leading companies as well, thereby benchmarking them.

And it would tell them or give them an indication of whether their performance was strong or weak relative to the comparison that was used.

Snowball Deposition at p. 11. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] Id. at p. 29.

As such, Registrant's services deal with the creation and building of brands whereas Petitioner's services deal with the analysis of existing business processes and benchmarking a company's performance in that process to determine if the measure up to other companies in their industry. The services could not be more distinct.

In this regard, it is respectfully submitted that the instant du Pont factor favors the continued registration of Registrant's mark and, moreover, given these distinctions there is no corresponding presumption that the trade channels of the parties overlap as the services themselves are distinct.

B. Petitioner Is Entitled to a Narrow Scope of Protection for its Registered Mark

1. Surname Plus Generic Matter

As a threshold issue, it is noted that the Registrant's Mark and the Petitioner's Mark contain the same overlapping element: the surname HACKETT. As the prosecution history of the Registrant's Mark confirms, Registrant accepted registration of its mark on the Supplemental Register conceding, as the office alleged, that its mark was primarily merely a surname under

Section 2(e)(4) of the Trademark Act. As such, it is submitted that the Board take notice of the common surname significance of the term HACKETT as required by Registrant and afford Petitioner only a narrow scope of protection for its surname mark it now seeks to enforce against the Registrant who has established the significance of the surname at issue by the testimony in this matter.

Within that context, and specifically recognizing the narrow scope of protection which is afforded to surnames under the Trademark Act, it is submitted that the consumers will look to the other elements in Registrant's and Petitioner's respective marks to distinguish between the two sources of the services provided thereunder.

Specifically, Registrant's Mark is for HACKETT CONSULTING. Petitioner's relied-upon registration is for THE HACKETT GROUP. The examining attorney for Registrant's Mark, recognizing the narrow scope of protection afforded to surnames, permitted the registration of Registrant's Mark despite the existence of Petitioner's Mark on the register reasoning that the distinct additional matter, even if generic or descriptive in its own right, was sufficient to distinguish the source of the respective services provided by the involved parties herein.

In this regard, and given the narrow scope of protection which should be afforded to a surname when combined with generic or descriptive matter, it is submitted that the marks are not sufficiently similar given the respective weaknesses thereof to create a likelihood of confusion. As such, it is submitted that this du Pont factor also favors continued registration of the Registrant's Mark.

2. Petitioner Has Failed to Establish the Acclaim its Trademark

A mark with extensive public recognition and renown deserves and receives more legal protection than an obscure or weak mark. *Kenner Parker Toys v. Rose Art Industries*, 963 F.2d 350, 353, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). See also *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 1327, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). This factor can play a dominant role in likelihood of confusion cases wherein the pleaded marks are established as famous. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); *Recot Inc.*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000). However, because of the extreme deference accorded to a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting fame to clearly prove it. *Lacoste Alligator S.A. v. Maxoly Inc.*, 91 USPQ2d 1594, 1597 (TTAB 2009); *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007). Moreover, achieving fame for a mark in a marketplace where countless symbols clamor for public attention often requires a very distinct mark, enormous advertising investments, and a product of lasting value. *Kenner Parker*, 963 F.2d at 352, 22 USPQ2d at 1456.

In the instant case, Petitioner contends that its mark is acclaimed, or famous, because it is

- a. A publicly traded company;
- b. Retains offices throughout the world;
- c. Has services used by the world's largest companies.

Petitioner, by counsel, then combines these three statements to make the leap that there is significant public recognition of the Petitioner's Mark. However, this statement is wholly unsubstantiated by the record.

First, Petitioner contends that by virtue of the fact it is publicly traded the company's financial placement in a public stock exchange somehow equates to brand recognition. However, the Petitioner offers no support whatsoever for this premise. Second, the Petitioner relies on the fact that it maintains offices in a few handfuls of cities around the globe but, again, fails to introduce evidence as to how maintaining offices in foreign countries, or a few offices here in the United States, equates to acclaim among the general consuming public.

Third, Petitioner asserts that Petitioner's Mark, by provision of services to the largest companies in the world, has garnered general consumer acclaim. As a threshold issue, it is noted that Petitioner submitted no evidence of brand recognition by the executives within these companies of whom they claim to have this acclaim. Although testimony was provided by the Petitioner that their services are performed for these companies, no witnesses or evidence was brought forth to establish this contention, namely, that the executives at these companies recognize Petitioner's Mark.

Even assuming, *en arguendo*, such evidence was adduced before this tribunal, evidence that a handful of highly sophisticated executives for the world's largest companies recognize your brand because you provide services for them is simply not sufficient to establish general acclaim in the broader consumer marketplace.

As such, it is respectfully submitted that the Petitioner has not, and did not, establish Petitioner's Marks to retain special acclaim in the industry among the relevant consuming public.

3. Petitioner's Alleged "Family of Marks" is Irrelevant as Registrant Does Not Offer Benchmarking Services

The "family of marks" doctrine has applicability in those situations where, prior to a defendant's first use of its challenged mark containing a particular feature, the plaintiff had established a family of marks characterized by that feature, so that the defendant's subsequent

use of its mark containing the feature for goods or services which are similar or related to plaintiff's will cause the relevant purchasing public to assume that defendant's mark is yet another member of the plaintiff's family. See *J&J Snack Foods Corp. v. McDonald's Corp.*, 18 U.S.P.Q. 2d 1889, 932 F.2d 1460, 1463 (Fed. Cir. 1991); *Blansett Pharmaceutical Co. Inc. v. Carmrick Laboratories Inc.*, 25 USPQ2d 1473 (TTAB 1992); *Econo-Travel Motor Hotel Corp. v. Econ-O-tel of America, Inc.*, 199 USPQ 307 (TTAB 1978); and *Porta-Tool, Inc. v. DND Corp.*, 196 USPQ 643 (TTAB 1977).

As a threshold issue, there was little, if any, testimony as to when the Registrant began use of other common law marks to create its alleged family such that it is difficult, if not impossible, to determine whether such a "family" existed prior to Registrant's first use of Registrant's Mark. (emphasis added).

Moreover, Petitioner does not provide branding services, the services provided by the Registrant. Rather, as set forth in the identification of its registration and as clarified by Mr. Snowball, Petitioner provides benchmarking analytical services. As such, any "Family of Marks" alleged to exist by Petitioner in this proceeding is relegated to its recited benchmark services. Accordingly, any such family is irrelevant to the instant proceeding as Petitioner's core services do not extend into the sphere of commerce occupied by Registrant.

C. There is No Overlap in the Marketing of The Respective Marks

In regard to advertising, there is simply no overlap between the manners in which Petitioner and Registrant advertise their respective diverse services.

Registrant's services are marketed mainly through word of mouth and through individuals that personally know Mr. Hackett. Registrant's Deposition at p. 16. Registrant's services are also marketed through its website located at www.hackettconsulting.com. Id. at p.

17. See also Registrant's Deposition, Exhibit C. Of note, however, its website does not generate new client contacts. Rather, it is used as a tool to build credibility with prospective customers once they have heard of Registrant's services by and through word-of-mouth advertising. *Id.* at p. 19. As Mr. Hackett testified, one hundred percent of the work Registrant receives is from word-of-mouth referrals for the small businesses he represents. *Id.* at p. 20. This is typical of brand development businesses in the nature of the services that Mr. Hackett provides.

To the contrary, Petitioner relies heavily upon referrals and returning business from executives in large companies it has performed services for in the past. Snowball Deposition at p. 14. These referrals come from the companies Petitioner represents, namely, large Fortune 500 companies and those having no less than 25 million to 50 million [in sales per year].” Id. at p. 103. See also id. at pp. 38, 101; Snowball Deposition, Exhibit 3, at PET 000387. This would be typical for services which can only be afforded by the largest of companies in the world.

██████ Id. at pp. 61-62, 94. Again, this would be typical for benchmarking services provided to the largest companies in the world. Standard brand development companies such as the Registrant would not market in this manner.

that meeting to the executive. Id. In terms of benchmarking, Petitioner's employees then describe what is covered in the full taxonomy of their benchmarking services. Id.

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] Id. at p. 40. This is completely distinct and apart from how the Registrant's services reach its consumers and, more generally, the channels of trade by and through Registrant's services typically reach consumers in the brand development industry.

Moreover, Mr. Hackett testified that "...what I offer is not relevant to big companies; big companies have marketing groups that do exactly what I do." Hackett Deposition at p. 23. As such, and given the distinctions in target consumers, it cannot be said that the marketing channels of the Registrant and the Petitioner are the same or overlap in any manner.

Additionally, even assuming, en arguendo, they were, Mr. Hackett provided testimony concerning the large corporate procurement process. See generally Registrant's Deposition at pp. 24-26. Specifically, vendors for large companies, such as The Hackett Group, Inc., are vetted by the companies prior to becoming authorized vendors therefore. Id. at p. 25. The vetting process entails looking at different proposals from vendors, examining their cost structure, determining the quality of the vendor's work, and sometimes even going to the vendor's facilities to make sure that the same are adequate to provide services for the large company. Id. at pp. 25-26. Based upon this knowledge, Mr. Hackett opined that it would not be conceivable

for large Fortune 500 company to hire the wrong vendor. Id. at p. 26. (emphasis added). As such, this additional requirement in the channels of trade for large companies not provided by Petitioner further distinguishes the channels of trade for the respective parties.

As such, it is respectfully submitted that this du Pont factor strongly weighs against a finding of a likelihood of confusion.

E. Sophistication of Purchasers

Mr. Snowball conceded in his trial testimony that Petitioner's benchmarking services "...is focused on preeminent brands..." Snowball Deposition at p. 13. Specifically, Petitioner has provided its services to the largest company in the world, Walmart, but has only dipped to companies that are around or below the hundred million dollar revenue size. Id.

Mr. Snowball specifically testified that Petitioner's services "are most palatable to companies that are 500 million and above and most comfortable to a billion and above" further adding "I would be surprised if we marketed to a firm less than a million in revenue". Snowball Deposition at pp. 100-101. In reference to the smallest of clients served by Petitioner, Mr. Snowball testified "I know we have served very small clients through a benchmarking capacity . . . companies around 25 million to 50 million in the benchmarking database." Id. at 101.

Mr. Hackett added that, based upon his experience working in the marketing departments of Fortune 500 companies, he had only seen brands of \$100 million or more get benchmarking studies like the kind provided by the Petitioner. Registrant's Deposition at pp. 46-47.

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED] Id. See also Snowball Deposition at p. 38.

The largest companies in the world, as set forth above, have sophisticated procurement processes that eliminate any possibility of confusion due to the significant vetting process that is undertaken to qualify vendors for service for their companies. See generally Registrant's Deposition at pp. 24-26.

As such, it is respectfully submitted that the consumers of Petitioner's services are highly sophisticated executives and corporations with substantial vendor vetting processes and, as such, this du Pont factor also favors continued registration of the Registrant's Mark.

F. There is Has Been No Actual Confusion in the Marketplace

In the instant matter there is no evidence of actual confusion in the marketplace despite co-existence in the marketplace since 2008. While Petitioner fails to address this factor, it is nonetheless relevant for the Board's determination. See *The Sports Authority Michigan, Inc. v. The PC Authority, Inc.*, 2002 TTAB LEXIS 65; 63 U.S.P.Q.2D (BNA) 1782 (holding the absence of actual confusion even where the opposing marks have co-existed for only a few years is a factor which favors an applicant in the registration of its mark.); *Central Soya Co., Inc. v. North American Plant Breeders*, 212 USPQ 37, 48 (TTAB 1981) ("the absence of actual confusion over a reasonable period of time might well suggest that the likelihood of confusion is only a remote possibility with little probability of occurring.")

As such, in the absence of any actual confusion whatsoever this du Pont factor weighs heavily against finding a likelihood of confusion.

G. Balancing of du Pont Factors

In the instant case balancing the du Pont factors favors the continued registration of Petitioner's Mark.

Examining the registrations at issue, the services are distinct and do not overlap in the marketplace. Although the marks both incorporate the term HACKETT, based upon the name being a surname the relied-upon mark should be entitled to a narrow scope of protection and thus confusion is not likely.

In regard to the marketing of the respective marks, they are completely different with the marketing for benchmarking services being provided exclusively to Fortune 500 companies and the like whereas Petitioner's services are marketed to individuals and small businesses on a one-on-one basis by Mr. Hackett.

Moreover, the channels of trade are distinct and the sophistication of Petitioner's consumers and their procurement process is more than sufficient to preclude even the slightest chance of a likelihood of confusion. This fact is further supported by the fact that there is not even one scintilla of evidence of actual confusion in the 5 years that these trademarks have co-existed in the marketplace.

In this regard, and based upon the record in this case, it is respectfully submitted that all of the du Pont factors favor a finding of an absence of a likelihood of confusion, that the instant grounds for this cancellation be denied, and that Petitioner's Mark remain registered on the Supplemental Register for the U.S. Patent and Trademark Office.

H. Expansion of the Marketplace and Petitioner's Alleged Common Law Rights

Finally, in Petitioner's Brief Petitioner effectively submits a dual argument setting forth that it (1) has expanded into Registrant's line of services although it has yet to acquire a

trademark registration for the same and (2) that Petitioner would retain superior rights to the disputed mark by virtue of its prior registration for benchmarking services under the doctrine of a natural zone of expansion. Both arguments are unsupported by the record.

First, as set forth above, Petitioner alludes to the fact that it has, at common law, begun use of its mark in connection with consulting services. However, nowhere in the record is there a date of first use in connection with these alleged common law services. As such, even if we were to assume such expansion has already occurred at common law, Petitioner would fail in its burden by virtue of the fact that it cannot establish priority of use for these services as they relate to the Petitioner's Mark vis-à-vis Registrant's uncontested priority of use date in Registrant's Mark of 2008.

Second, [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] Id. at p. 56.

Of note, Mr. Snowball provided a clear example of what he considered their consulting services to entail in terms of "prescriptive recommendations" as they apply to marketing. Mr. Snowball testified:

[REDACTED]

[REDACTED]

[REDACTED]

As such, it is respectfully submitted that from a common law perspective, Petitioner has failed to establish its burden of proof by virtue of the fact that (1) it did not establish priority of use in its alleged common law rights and (2) the services provided by Petitioner at common law are separate and distinct apart from Registrant's services. Moreover, Petitioner's expansion of trade doctrine argue should likewise fail as it has provided the testimony of Mr. Snowball concerning the services in which they intend, and have allegedly actually, expanded. And as set forth above, the simply do not overlap with those services provided by the Registrant.

CONCLUSION

WHEREFORE the Applicant, Hackett Consulting, by counsel, respectfully requests that the Board deny the instant cancellation proceeding and, for premises considered, maintain the instant trademark registration on the Supplemental Register of the U.S. Patent and Trademark Office.

Respectfully submitted this 21st day of March, 2014.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

The Trademark Trial and Appeal Board

Registration No. 3,878,276,
For the mark HACKETT CONSULTING,

The Hackett Group, Inc.

Petitioner,

vs.

Hackett Consulting,

Registrant.

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Cancellation No. 92055460

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that I caused a copy of the foregoing this 21st day of March, 2014,
to be served, via first class mail, postage prepaid, upon:

Francisco J. Ferreiro
Malloy & Malloy, P.L.
2800 SW Third Avenue
Miami, FL 33129

/Matthew H. Swyers/
Matthew H. Swyers